REMARKS

I. Introduction

In view of the above amendments and the following remarks, reconsideration of the rejections contained in the Office Action of September 4, 2009 is respectfully requested.

By this amendment claim 1 has been amended, and claims 8, 12, 14, and 17 have been cancelled without prejudice or disclaimer to the subject matter contained therein. Claims 1-2, 4-7, 9-11, 13, 15-16, and 18-21 are now pending in the application. No new matter has been added by these amendments.

II. MPEP 714.13

As mentioned above, claim 1 has been amended. Because the only amendment to claim 1 consists of incorporating previously considered claim 8 into claim 1, Applicants submit that no new issues requiring further search and consideration are raised by this amendment. (See MPEP 714.13 and 37 C.F.R. § 1.116)

III. 35 U.S.C. § 112

On page 2 of the Office Action, claims 12, 14, and 17 are rejected as being indefinite. These rejections are believed to be moot in view of the cancellation of claims 12, 14, and 17; withdrawal of the rejections is thus respectfully requested.

IV. Prior Art Rejections

Currently, claims 1, 2, 5, 8, 9, 13, 14, and 21 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Kazunori (JP 11-216985), claim 10 stands rejected under 35 U.S.C. §

103(a) as being unpatentable over Kazunori, and claims 4, 6, 7, 11, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kazunori in view of Siegel (US 3,250,033).

Claim 1 is patentable over Kazunori and Siegel, whether taken alone or in combination, for the following reasons. Claim 1 requires a barrel for a writing implement, comprising: a barrel body having a gripping part; and a grip member of layered structure formed by assembling an inner member of a soft material and an outer member, the grip member being disposed on the gripping part of the barrel body, wherein the inner member is covered with the outer member, and the grip member is formed in an assembly facilitating shape for facilitating putting the outer member on the inner member, wherein each of the inner member and the outer member is formed prior to putting the outer member on the inner member such that each of the inner member and the outer member constitutes a preformed member, wherein the assembly facilitating shape is a tapered configuration, the inner member being tapered from a back part thereof to a front part thereof and the outer member being tapered from a front part thereof to a back part thereof, and wherein the inside diameter of the outer member is greater than the outside diameter of the inner member, and the outer member is axially compressed when put on the grip part of the barrel body.

On page 3 of the Office Action, the prior art rejection cites the shaft tube (1) of Kazunori as corresponding to the barrel body of claim 1, the diameter reduction part (10) and grip member (11) as corresponding to the gripping part of the barrel body of claim 1, and also cites the diameter reduction part (10) as corresponding to the inner member of the grip member of claim 1 and the member (11) as corresponding to the outer member of the grip member of claim 1. In other words, the two structures constituting the diameter reduction part (10) and grip member

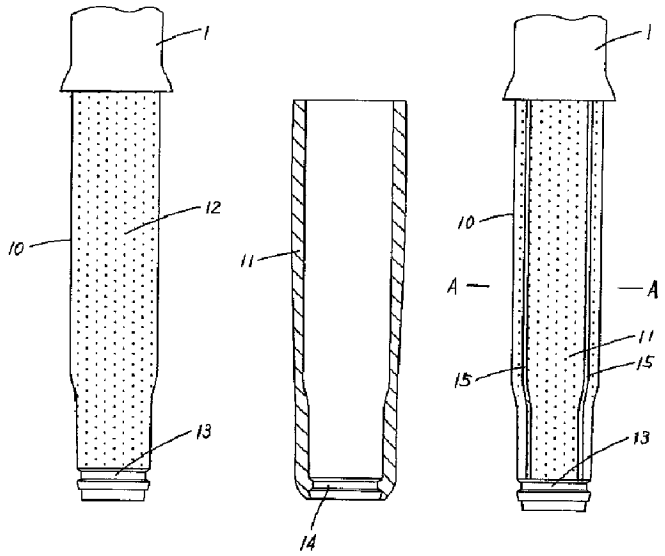
(11) of the Kazunori reference are asserted as corresponding to three structures in claim 1: the gripping part, the outer member, and the inner member.

Binding legal precedent from the United States Court of Appeals for the Federal Circuit establishes that a claim requires multiple structures simply by virtue of the fact that the structures are recited in the claim using distinct terminology. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (holding that a claim which recited three structures: a closure member, a landing member, and a disposal means, could not be anticipated by a prior art reference which taught only two corresponding structures, even though the two structures in the prior art were capable of performing all the functions of the three structures recited in the claim.) In reversing the Board of Patent Appeals and Interferences, the Federal Circuit held that "the Board failed to recognize that the third mechanical fastening means in claim 76, used to secure the diaper for disposal, was separate from and independent of the two other mechanical means…" *Id.* at 745. In failing to identify a separate and independent structure as required by the claim at issue, the prior art rejection in *Robertson* failed to establish that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Id.*; see also MPEP 2131 ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.")

As discussed above, the prior art rejection set forth in the Office Action asserts that the diameter reduction part (10) and the grip member (11) of Kazunori correspond to the gripping part, the outer member, and the inner member of claim 1. In making these assertions, the prior art rejection improperly correlates a single structure in the prior art to multiple distinct structures required by the claims. As explained by the Court of Appeals for the Federal Circuit in the

Robertson case, because each separate and independent structure required by the claims is not disclosed in the prior art, the prior art rejection is improper.

Moreover, in addition to being improper as a matter of law, the prior art rejection set forth in the Office Action also fails to establish that the requirements of claim 1 interrelating the above-discussed structures are met. Specifically, claim 1 requires a barrel having a gripping part, and a grip member disposed on the gripping part, the grip member itself being a layered structure including an inner member and an outer member. In other words, claim 1 requires a layered structure disposed on a portion of the barrel. However, the Kazunori reference discloses only a single structure (11) disposed on the portion of the barrel (10). Because Kazunori does not disclose a barrel body having a gripping part and a grip member of layered structure formed by assembling an inner member of a soft material and an outer member, the grip member being disposed on the gripping part of the barrel body, Kazunori cannot meet the requirements of claim 1.



Figures 3, 4, and 5 of Kazunori (JP 11-216985)

Additionally, claim 1 requires that the inner member and the outer member are preformed members with the inside diameter of the outer member being greater than the outside diameter of the inner member, and the outer member being axially compressed when put on the grip part of the barrel body. In contrast, Kazunori discloses a configuration in which a grip member (11) is press-fitted onto the barrel body. (See paragraph 0006 of the machine translation, "the grip member 11 which consists of an elastomeric-properties object is pressed fit in the diameter reduction part 10.") Because Kazunori does not disclose the inner member and the outer member being preformed members with the inside diameter of the outer member being greater than the outside diameter of the inner member, Kazunori cannot meet the requirements of claim 1.

Further, claim 1 requires that the outer member is axially compressed when put on the grip part of the barrel body. As discussed in detail in the specification, the outer member (5) is axially compressed between the barrel body 2 and the back surface (6a) of the barrel cap (6). In contrast, Kazunori discloses a configuration in which the grip member (11) is press-fitted onto the barrel body, and thus it is not necessary that the grip member be axially compressed. Because Kazunori does not disclose the outer member being axially compressed when put on the grip part of the barrel body, Kazunori cannot meet the requirements of claim 1.

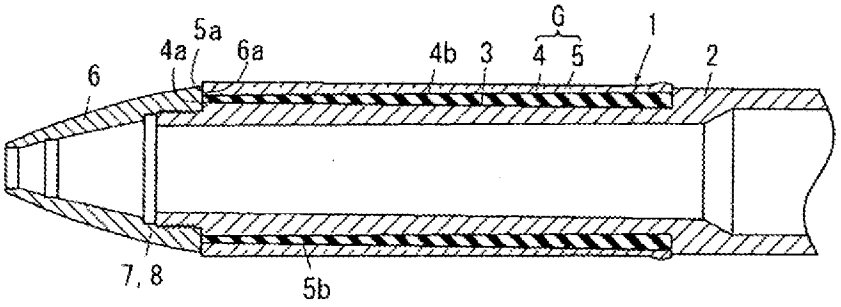


Figure 1 of the present application

As discussed in detail in the specification, the configuration of the present invention yields a grip member of a layered structure in which the layers are separable (see claim 11) but which is also securely fastened to the barrel of the writing implement such that forces occurring during use of the writing implement do not displace the grip member. These advantages are directly related to the claim configuration in which the inner member and the outer member are preformed members with the inside diameter of the outer member being greater than the outside diameter of the inner member, and the outer member being axially compressed when put on the grip part of the barrel body. Neither the configuration nor the advantages of the present application are disclosed by the prior art of record, and it appears that there would have been no reason to modify any of the prior art of record to yield a configuration which would meet the requirements of claim 1. It is thus submitted that the invention of the present application, as defined in claim 1, is not anticipated nor rendered obvious by the prior art, and yields significant advantages over the prior art. Allowance is respectfully requested.

Claims 2, 4-7, 9-11, 13, 15-16, and 18-21 depend, directly or indirectly, from claim 1 and are thus allowable for at least the reasons set forth above in support of claim 1.

In view of the foregoing amendments and remarks, inasmuch as all of the outstanding issues have been addressed, Applicants respectfully submit that the present application is now in condition for allowance, and action to such effect is earnestly solicited. Should any issues remain after consideration of the response, however, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,

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